

REMARKS

By this amendment, claims 1-29 are pending. No new matter is introduced.

The Office Action mailed May 30, 2003 rejected claims 1-3, 6, 7, 9-15, 17-18, and 20-29 as obvious under 35 U.S.C. § 103 based on *Tönnby et al.* (US 6,515,996) in view of *Itoi* (US 6,456,625), claims 4-5, 16, and 19 as obvious under 35 U.S.C. § 103 based on *Tönnby et al.* in view of *Itoi* and further in view of *Awadalleh* (US 6,449,251), and claim 8 as obvious under 35 U.S.C. § 103 based on *Tönnby et al.* in view of *Itoi* and further in view of *Szeliga* (US 6,067,353).

Claim 1 recites “wherein the telephone interface means is adapted to **patch a call from the one telephone to the circuit switched telephone network** via the network interface means **upon a determination that no data connection is established to the circuit switched telephone network.**” Independent claim 9 recites “wherein the telephone interface means is adapted to **passively patch a call from said telephone to the circuit switched telephone network** via the network interface means.” Independent claim 17 recites “**determining whether a data connection is established with the circuit switched telephone network**” and “**patching a call initiated from the telephone to the circuit switched telephone network** via the network interface means based upon the determining step.” Claim 25 includes the feature of “the plurality of interfaces support **patching a call from the telephone to the circuit switched telephone network upon a determination that no data connection is established to the circuit switched telephone network.**” Claim 26 recites “**determining whether a data connection is established with the circuit switched telephone network**” and “**patching a call initiated from a telephone to the circuit switched telephone network** based upon the determining step.”

To satisfy the above features, the Office Action, on page 3, refers to the movable contact 71 of FIG. 8, and contends “for establishing a telephone call via PSTN if PC does not establish

with a service provider.” Applicants respectfully disagree with this assertion, as *Tönnby et al.* provides no disclosure of “a determination that no data connection is established to the circuit switched telephone network.” The above extrapolation ignores the specifics of the claim language.

Tönnby et al. discloses, on col. 8: 52-col. 9:3, that the IP modem 4 operates into different modes depending on user A’s desires and depending on the kind of services required by A. The IP-network and PSTN/ISDN network services available from the IP modem have been described in connection with FIGS. 1-5. In FIG. 6 the basic telephony service is shown. The IP modem 4 comprises a relay 69 with two movable contacts 70, 71. Contact 70 is adapted to be connected the wall socket in A’s premises and from there to the subscriber line to the local office. Contact 71 is adapted for connection to user A’s telephone loop 57. Each movable contact can move between two stationary contacts, two of which are interconnected by a cable 72. When the movable contacts are in the position shown in FIG. 5 basic telephony mode is provided. When the movable contacts are in their opposite positions the IP mode described in connection with FIGS. 1-5 is provided. In the position shown in FIG. 6 a telephone connection is hard wired through the IP modem. In this position A’s telephone apparatus will be connected, usually via a non shown wall socket, to the subscriber line.

As evident from the above discussion, the *Tönnby et al.* system never requires “a determination that no data connection is established to the circuit switched telephone network,” but in fact, circumvents this feature by hardwiring the connections via the movable contacts 70, 71.

Applicants noted this deficiency with respect to the applied reference of *Itoi* in Applicants’ previous response dated Mar. 19, 2003. For convenience, this argument is reiterated. *Itoi* is directed to a system supporting speech over an analog telephone set or an Internet phone

device in a LAN telephone network (see Abstract). As evident from FIGs. 3A and 3B, and accompany text, the *Itoi* system strictly operates in a LAN environment without any connection to a “circuit switched telephone network,” as positively recited in the claims. For example, *Itoi* (col. 10, line 48 – col. 11, line 52), discloses a call control process as described in relation to Figure 10, solely in relation to telephone numbers corresponding to IP addresses, and therefore, cannot operate with a circuit switched telephone network.

Therefore, *Tönnby et al.* and *Itoi*, either individually or in combination, fail to disclose the features of the independent claims 1, 9, 17, 25, and 26.

Furthermore, the Office Action has engaged in impermissible hindsight in proposing the combination of *Tönnby et al.* and *Itoi*. The Office Action, on page 4, states that the motivation to combine the two references “would have been to increase the number of devices that can access the internet.” Not only does this suggested motivation does not stem from any of the references, but the conclusion is factually incorrect. There is no disclosure in *Tönnby et al.* of a need or object to allow more devices to connect to the Internet. Moreover, even the combination of *Tönnby et al.* and *Itoi* does not render this unsupported statement true. That is, the modified *Tönnby et al.* system would not operate to support more devices then the unmodified system. The proposed modification of *Tönnby et al.* to add *Itoi*’s function of providing local IP addresses to the Internet phone devices and to analog telephone sets is unnecessary, adding no extra functionality to the *Tönnby et al.* system, other than complexity and cost. Notably, the *Tönnby et al.* system does not assign internal network addresses for the telephone 1 and the computer 2, but rather employs an external IP address of the subscriber line 5 in the IP modem 4, and provides multiplexor/demultiplexor functions to support multiple devices (col. 17:30-36). Other than simply describing a way that Internet and analog telephones receive IP addresses in a LAN environment, *Itoi* provides no motivation or suggestion to modify the *Tönnby et al.* system in the

manner proposed in the Office Action. One of ordinary skill in the art would find no motivation to include an internal network address assigning function in the IP modem 4 of *Tönnby et al.* to implement an operation that is already performed by the multiplexing and de-multiplexing functions.

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. Although a prior art device “maybe capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Neither *Tönnby et al.* nor *Itoi* provides any suggestion or motivation for the construction proposed by the Office Action. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants’ structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

The secondary references of *Awdallah et al.* and *Szeliga* do not fill in the gaps of *Tönnby et al.* and *Itoi*. *Awdallah et al.* was applied for features relating to setting priority to the voice and data packets, and *Szeliga* was cited for a supposed teaching of a visual call waiting indicator.

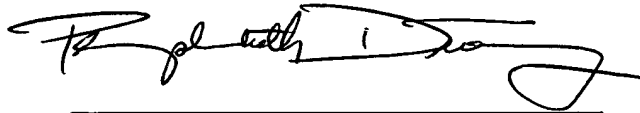
Therefore claims 1, 9, 17, 25, and 26 should be indicated as allowable. Dependent claims 2-8, 10-16, 18-24, and 27-29 are also allowable for at least the same reasons as their independent claims and are separately patentable on their own merits.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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